

REMARKS:

I. Status of the Claims

Claims 57, 58, and 62–70 are pending, claims 1–56 and 59–61 are canceled, and claim 57 is amended. Claim 57 is rephrased to positively recite a method step. No new matter is entered by way of this amendment.

II. 35 U.S.C. § 112 Rejection

Reconsideration is respectfully requested of the rejections of claims 57 and 62–67 under 35 U.S.C. § 112, second paragraph.

Claim 57, as amended, positively recites a method step of “using the ionic liquid comprising an anion and a cation”, and, as such, is now in compliance with guidelines of MPEP 2173.05(q). Claims 62–67, which depend from and incorporate the limitations of claim 57, likewise are definite for at least the same reasons as claim 57. For the foregoing reasons, the Applicant respectfully requests withdrawal of the § 112 rejections of claims 57 and 62–67.

III. Double Patenting

Claims 57, 58 and 62–70 are provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 17 and 18 of copending U.S. Application No. 13/170,686 (published as U.S. Pat. App. Pub. No. 2011/0257433). To overcome this rejection, the Office recommends to timely file a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) or 1.321(d). Per the Office's recommendation, Applicant will file a terminal disclaimer upon recognition of the patentability of the remaining claims should the co-pending application issue first.

IV. 35 U.S.C. § 102 Rejections

Reconsideration is respectfully requested of the rejections of claims 57 and 62–67 under 35 U.S.C. § 102(b) in view of Fuzesi (U.S. Pat. No. 4,219,624).

Claim 57 is directed to a method for using an ionic liquid in a variety of applications in which the cation of the ionic liquid is a tertiary ammonium ion comprising

an hydroxyl-substituted alkyl group (e.g., the ionic liquid is N,N-dimethylethanolammonium formate).

The method of claim 57 is patentably distinguishable from Fuzesi because Fuzesi fails to disclose using a compound comprising a tertiary amine as i) a solvent for an enzyme-catalyzed reaction, ii) a solvent for organic synthesis, iii) a matrix in MALDI-MS, iv) a solvent for extraction, catalysis, or liquefaction, v) a nuclear fuel reprocessing medium, vi) a fuel cell additive, vii) an electrochemical application, viii) pervaporation, ix) drug delivery, x) lubrication, xi) hydraulics, xii) adhesives, xiii) sensors, xiv) biocides, or xv) chromatographic media. Rather Fuzesi describes a method for stabilizing an amine catalyst used in a premix polyol composition containing a halogenated polyol for use in the production of polyurethane foam. The method involves acid-blocking the amine catalyst to minimize deactivation, in particular a dimethylethanolamine catalyst is blocked through reaction with formic acid (See, Table III.) Fuzesi, therefore, uses an acid-blocked tertiary amine as a catalyst to catalyze the reaction between polyisocyanate and the halogenated polyol to form polyurethane foam (See, column 5, lines 20-30). Fuzesi explicitly states throughout the patent that the amine component (i.e., dimethylethanolamine) acts as a catalyst—not as a solvent—and that the acid component merely stabilizes the amine. (See, for example, at col. 2, lines 1–5 and col. 4, lines 41-49). Moreover, it is well known in the art that a catalyst is not a solvent.

For a reference to anticipate a claim, it must disclose each and every element of the claim. Because Fuzesi does not disclose the use of an acid-stabilized tertiary amine in any of the applications listed in claim 57, this reference cannot anticipate this claim. Thus, it is respectfully submitted that claim 57 is novel in view of Fuzesi. Claims 62–67, which depend from and incorporate the limitations of claim 57, likewise are not anticipated by Fuzesi for the same reasons stated above with respect to claim 57. For the foregoing reasons, the Applicant respectfully requests withdrawal of the § 102 rejections of claims 57 and 62-67 in view of Fuzesi.

V. Conclusions

In light of the above, the Applicant requests entry of the claim amendments, withdrawal of the claim rejections, and solicits an allowance of all pending claims. The Examiner is invited to contact the undersigned practitioner should any issues remain unresolved.

Respectfully submitted,

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